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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/709,086 | 04/13/2004 | Carlo Smith | DD-P0010 | 3085 |

36067 7590 02/07/2006

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| EXAMINER |
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NEWTON, JARED W

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| ART UNIT | PAPER NUMBER |
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3634

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------|--|
| Office Action Summary | Application No. 10/709,086 | Applicant(s) SMITH ET AL. | |
| | Examiner Jared W. Newton | Art Unit 3634 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6-8, 10, 11, 12, 15, 16-18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,020,043 to Kohler.

Kohler discloses an apparatus for extracting and storing disks comprising a base 2 having disk grooves 14, said base adapted to couple to a cover 1 having an upper groove capable of receiving a disk or a writing implement, and an extraction slot behind pull-off tab or door 12 allowing for the extraction of a disk 30 without removing the cover (see FIG. 1). Kohler further discloses a lever 7 configured to extract the disks 30 (see FIG. 1).

Kohler further discloses said apparatus comprising: means 14 for placing a disk in a bundle package; means 3 for engaging a bundle base 2 with a cover 1 (see FIG. 2); means for removing said disk via an extraction slot 14 without disengaging said bundle cover 1 with said bundle base 2 (see FIG. 1); a means for placing said disk 30 in a disk groove 14 coupled with the overall apparatus; and, means 7 for actuating an extractor couple with an extraction slot (see FIG. 1).

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Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,797,488 to Yemini.

Yemini discloses a case comprising a base 14 connected to a cover 12, said base comprising an extraction slot 30, wherein an extractor 32 extends from said slot to extract a disk 34 from said case (see FIG. 1).

In regard to claims 11, 12, and 15, the method set forth in the claims is inherent within the structure and disclosure of the Kohler reference. In particular, Kohler discloses fixedly engaging a cover 1 and a base 2 via axle 3 in order to form an overall apparatus or package, wherein said package comprises an extraction slot disposed in said cover 1 and accessed via door 12 so as to allow access to disks 30 without detaching said cover from said base (see FIGS. 1 and 2). Kohler further discloses placing disks 30 in disk grooves 14, wherein said grooves are coupled within said overall package, and a lever 7 is actuated by a user in order to aid in extracting said disks 30 from said slots (see Column 4, Lines 50-56).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 13, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over '043 to Kohler as applied to claims 1-3, 6-8, 10, 11, 12, 15, 16-18, and 20 above, and further in view of US Patent No. 6,625,959 to Gordon et al. Kohler discloses an apparatus comprising all of the limitations of claims 1, 11, and 18 as set forth above, but does not disclose a writing implement. Gordon et al. discloses a disk packaging comprising a base section 400 and a cover section 428, wherein said base section comprises a plurality of slots 422 adapted to store a writing implement including pens, pencils, and the like (see FIGS. 16 and 17). The Kohler and Gordon et al. references are analogous art because they are from the same field of endeavor—disc support apparatuses. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the writing implementation slots as set forth by Gordon et al. in the base of the apparatus as disclosed by Kohler. The motivation would have been to provide a means of storing a label-marking device. Kohler sets forth the desirability of indexing the different disks stored in the apparatus. It would be an obvious improvement to incorporate a means for storing pens, pencils, etc. within the apparatus via slots as set forth by Gordon et al. The motivation would be to enable the apparatus, including the indexes and a means of marking said indexes, to travel or be moved as one unit.

With respect to recitations regarding writing implementations and disks, it is noted that since this recitation is functionally reciting specific unclaimed elements, a reference need not explicitly show use with those elements. Rather, a reference need only *be capable* of being used in such a way as claimed. The above claim rejections

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reflect the interpretation of the claims based on the functional recitation of said elements.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

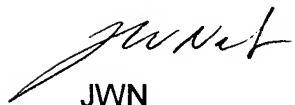
- US Patent Application Pub. No. 2003/0213758 to Bennett et al.
- US Patent Application Pub. No. 2001/0050239 to Ishii
- US Patent No. 5,931,295 to Kaupp
- US Patent No. 5,799,787 to Talbot
- US Patent No. 5,676,246 to Gloger
- US Patent No. 5,586,650 to Yeh
- US Patent No. 5,535,884 to Scott et al.
- US Patent No. 5,076,444 to Syms
- US Patent No. 4,609,232 to Florence
- US Patent No. 3,007,702 to Eby

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared W. Newton whose telephone number is (571) 272-2952. The examiner can normally be reached on M-F 8-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JWN

February 2, 2006



RICHARD E. CHILCOT, JR.
SUPERVISORY PATENT EXAMINER